

REMARKS

I. STATUS OF THE CLAIMS

Claims 1-6 and 9 - 37 are now pending in the present application, with Claims 12, 21 and 31 having been amended as noted above. In the Office Action mailed October 31, 2007, claims 1-6 and 9 - 37 were rejected. Applicants respectfully request reconsideration of such rejections.

II. CLAIM REJECTIONS UNDER 35 U.S.C. §103(a)

A. Rejection of Claims 1 – 6 and 9 – 11

Claims 1 – 6 and 9 – 11 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Johnson, et al.* (U.S. 6,270,093), in view *McCue, et al.* (U.S. 6,513,817). The Official Action states that *Johnson, et al.* "teaches a cart arrangement having a utilitarian theme, including a molded plastic body portion (52), which defines a seat portion (40, 42, 44, 46), and at least one of which (42) a rider may sit facing forwardly...a basket (4/8) fixedly attached to the body...the basket having first and second sides, as well as a bottom, which is positioned forwardly of the seat, and wherein at least a substantial portion of the seat portion (e.g., 44, 46) is located above the side of the basket bottom." The Examiner also notes that *Johnston, et al.* "fails to teach the molded portion as having a basket portion, which receives the portion of the basket in a covering relationship." The Official Action, however, states that *McCue, et al.* teaches a shopping cart arrangement with a molded portion including a seat portion, and concludes that it would have been obvious to one of skill in the art at the time of the invention to provide the molded portion of *Johnson, et al.* with a longitudinally extending further section, extending beyond the seat to cover at least a portion of the sides of the basket, as suggested by *McCue, et al.*, for the purpose

of presenting a visually unified appearance. Applicants respectfully request reconsideration.

Applicants respectfully submit that the attempted combination of *Johnson, et al.* and *McCue, et al.* is not suggested by the art, nor would it be sufficient to try to render the claimed invention obvious or unpatentable under 35 USC § 103(a), especially when the references are viewed in their entireties. It is well settled that to establish a *prima facie* case of obviousness, (i) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to those of ordinary skill in the art to modify the references or to combine reference teachings; (ii) there must be a reasonable expectation of success with such a combination; and (iii) prior art references, as modified, or combinations of references must teach or suggest all of the claimed limitations (see MPEP §§ 2142 – 2143). Still further, the necessarily required teaching or suggestion to make the claimed combination of references, and accordingly the reasonable expectation of success of such a combination, must both be found in the prior art and are not to be based on the Applicant's disclosure. *In re Vaeck*, 947 F. 2d 488, 20 USPQ 2d 1438 (Fed. Cir. 1991). In the rejection of claims 1 – 6 and 9 – 11, set forth in the current Official Action, there is no showing of the required suggestion or motivation to combine the cited references, or any expectation of success in making such a combination as is necessary to support the *prima facie* case of obviousness that must be made by the Examiner in order to support a rejection of these claims under 35 USC § 103(a).

The *Johnson, et al.* and *McCue, et al.* references both teach very specific shopping cart constructions that also are very different from each other. In particular, the multiple child seat, nestable shopping cart of *Johnson, et al.* is specifically designed to provide a basket-type shopping cart with two inwardly facing child seats positioned behind the basket in an

arrangement such that "a front overhanging portion of a basket of a similar cart may be nested over the seat and between the backrest to enable nesting of similar carts when the seats are unoccupied." (See, *Johnson, et al.* at Abstract; Fig. 16; col. 5, l. 65 – col. 6, l. 8). Thus, the primary and very necessary function served by the multiple child seat nestable shopping cart construction of *Johnson* is to enable a series of such carts to be nested together for storage. By contrast, the shopping cart of *McCue, et al.* is not capable of such nesting, nor is it designed to enable similar carts to be nested together in such an arrangement. Rather, the shopping cart of *McCue, et al.* is simply designed as a shopping cart basket mounted to a body resembling a vehicle, and its features such as pivoting handles 42, mirror housings 36 that extend outwardly from the sides of the body 22, further appear to prevent such nesting together of similar carts as required by *Johnson, et al.*

Accordingly, when these references are considered in their entireties, they seem to more clearly teach away from each other in terms of their stated purposes and constructions, such that there is no suggestion or modification, either expressly or impliedly made in these references to try to support their combination, and even if made, seemingly would require a substantial reconstruction of *Johnson, et al.* that still would not be successful at forming the claimed invention. The Examiner's contention that "it would have been obvious... to provide the molded portion (52) of *Johnson, et al.* with the longitudinally further section which extends behind the seat portion to cover at least a lower portion (e.g., the lower portions) of respective sides of the basket, as suggested by the longitudinally extending portion of the molded body of *McCue, et al.* for the purpose of presenting a visually unified appearance" is at best recognition (apparently based upon Applicant's disclosure) of a need not found or addressed in the cited references of

Johnson, et al. and *McCue, et al.* , either alone or in combination. Moreover, "[R]ecognition of a need does not render obvious the achievement that meets that need...recognition of an unsolved problem does not render the solution obvious." *Cardiac Pacemakers, Inc. v. St. Jude Medical, Inc.*, 381 F. 3d 1371 (Fed. Cir. 2004), *cert. den'd*, 125 S. Ct. 2254 (2005).

Instead of providing the required clear suggestion or motivation to combine the teachings of these references, as well as a showing of an expectation of success in making such a combination, it appears that the Official Action therefore simply picks and chooses between various elements of the cited references, without considering them in their entirety, to try to construct the claimed invention. Such a piecemeal approach to picking and choosing among various teachings of the cited references is not, however, permissible and smacks of a hindsight reconstruction based upon Applicants' disclosure. As expressly noted by the MPEP at § 2141:

...to reach a proper determination under 35 USC § 103, the Examiner must step backward in time and into the shoes worn by the hypothetical "person of ordinary skill in the art" when the invention was unknown and just before it was made. In view of all factual information, the Examiner must then make a determination whether the claimed invention "as a whole" would have been obvious at that time to that person. Knowledge of Applicants' disclosure must be put aside in reaching this determination, yet kept in mind in order to determine the "differences," conduct the search, and evaluate the subject matter as a whole" of the invention. The tendency to resort to "hindsight" based upon Applicants' disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and a legal conclusion must be reached based on the facts gleaned from the prior art.

Respectfully, it appears that the Examiner has failed to "step back in time" to when the invention of Claims 1 – 6 and 9 – 11 was unknown and has now tried to propose modifications and combinations of the cited references without regard to the teachings of such references as a whole. Such a combination would require a substantial, if not almost complete reconstruction of *Johnson* to incorporate all the teachings of *McCue, et al.*, for which there is no suggestion, no

motivation, and no incentive to try to make. This combination instead seems to be based simply on knowledge of Applicants' invention in order to try to meet and solve the problems addressed by the claimed invention. Accordingly, it is respectfully submitted that Claims 1 – 6 and 9 – 11 are patentable over the purported combination of *Johnson, et al.* in view of *McCue, et al.*, and therefore, the rejection of these claims under 35 USC § 103(a) should be withdrawn.

B. Rejection of Claims 12 – 37

Claims 12 – 37 are rejected under 35 U.S.C. §103(a) as being unpatentable over *McCue, et al.* and *Struzer* (U.S. 5,704,527). The Official Action states that *McCue, et al.* teaches a shopping cart having a theme-shaped molded plastic body defining a seat portion and with front and rear sections, lateral side, and a basket section having a front and rear, and with the seat having a back and a non-moveable basket made from a wire material and positioned such that the basket front is approximately the front of the basket accommodating portion of the frame. The Action does note, however, that *McCue, et al.* "fails to teach the provision of one of an audio device comprising a radio receiver or internal broadcast receiver, video display coupled to a VCR or disc player, or a video display coupled to an audio/video receiver." In fact, in response to Applicants' prior amendment, the Examiner has specifically noted and agreed with the Applicants that while *McCue, et al.* purportedly teaches, "an entertainment console that may include an electronic game, "it still fails to "teach the electronic devices as now specifically recited in the claims." (See Official Action p. 4). However, the Official Action goes on to assert that the reference of *Struzer* purportedly teaches that it is known to provide an entertainment device coupled to a wheeled transport vehicle such as a stroller and therefore concludes that it would

have been obvious to one of ordinary skill in the art at the time of the invention to provide the entertainment device suggested by *McCue, et al.* as an audio or video device as suggested by *Struzer*. Applicants respectfully request reconsideration.

As noted above, in seeking to combine various cited references under an obviousness analysis under §103(a), the references must be considered in their entireties for all that they teach, including those teachings that diverge away from the claimed invention, and simply because the prior art shows a particular limitation or element of the claims, does not mean that it should be modified or combined with another reference, unless the suggestion or motivation to make such a combination or modification is found, either expressly or implicitly in the references themselves or in the knowledge of those skilled in the art, which asserted combination still must have a reasonable expectation of success as well as teach all of the claimed limitations. See MPEP §§ 2142 – 2143. In the present case, *Struzer* simply teaches a mechanism for carrying a portable electronic device, which is designed for easy attachment and detachment from between the handles of a child's stroller, to carry the electronic device, rather than putting it in the mother's purse or in an overstuffed diaper bag (*Struzer* at col. 1, ll. 15 – 40). *Struzer* does not appear to even show the actual electronic device, but rather shows just a box with a pivoting lid and a series of attachment mechanisms for enabling quick attachment/detachment of this box from the arms of the stroller. The drawings of *Struzer* further do not illustrate how a child seated in the stroller and facing forwardly would be able to see, much less be entertained by a video or other, similar devices contained within the box strapped to the stroller.

As previously discussed with the Examiner, *McCue, et al.* only generally references potentially placing an electronic game devices on the console or dashboard area, but does not

each or illustrate how this would be accomplished. There thus does not appear to be any suggestion or motivation to try to combine the attachable/detachable box or straps of *Struzer* inside the passenger compartment of *McCue, et al.* Indeed, even if this combination were made, trying to clip or detachably hook the box of *Struzer* with an electronic device therein inside the cabin of *McCue, et al.* would appear to be very cumbersome and space consuming, and therefore would not appear to be practical as *Struzer* teaches that this mechanism is designed to be easily detachable or removable. As a further consequence, a child riding in the cart or a thief could detach and remove the box (and with it the electronic device therein, as taught by *Struzer*) and thus it would not be practical to try to modify *McCue, et al.* to accommodate such a removable or detachable bag or box concept within the cart of *McCue, et al.*

Accordingly, it is respectfully submitted that there has been no showing of any suggestion or motivation to try to combine the cited references, nor has there been any showing or a reasonable expectation of success in making such a combination. It is therefore submitted that Claims 12 – 37 are patentable over the cited combination of *McCue, et al.* and *Struzer* and consequently the rejection of these claims under 35 USC § 103(a) should be withdrawn.

CONCLUSION

In view of the foregoing remarks, Applicant respectfully asserts that the rejections of the claims as set forth in the non-final Office Action of October 31, 2006 have been addressed and that claims 1 – 6 and 9 – 37 as currently pending are in condition for allowance over the cited art of record. An early notice of allowance is accordingly solicited. Should the Examiner have any questions regarding the foregoing response, he is invited and urged to telephone the undersigned attorney.

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